SUPREME COURT, U. S.

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In the Supreme Court
OF THE
United States

OCTOBER TERM, 1967

No. 851

PACIFIC SCIENTIFIC COMPANY,
Petitioner,

vs.

AEROTEC INDUSTRIES OF CALIFORNIA, AEROTEC INDUSTRIES, INC., and UNIVERSAL OIL PRODUCTS COMPANY,
Respondents.

PETITIONER'S REPLY TO BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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Respondents' brief in opposition evades every issue:

1. Re the questions presented: The petition presents a square conflict of authorities as to the meaning and scope of the words "subject matter sought to be patented" and "art to which said subject matter pertains" in 35 U.S.C. 103. Instead of facing this issue, respondents talk about "the standard of patentability" and "restrict[ion of] the

applicability of pertinent prior art''—considered in *Graham v. John Deere Co.* (1966) 383 U.S. 1 (Br.Opp. 2). Sidestepping the problem of lack of substantive definition of the statutory terms—a ''central problem that has never really been faced'' (Petn. 26)—does not make it go away. The petition does not challenge *Graham* on the standard of patentability; it seeks a resolution of the important questions which *Graham* did not reach. These questions are plainly spelled out in the petition, and revealed in the decisions therein cited.

Respondents' dismissal of the third question stated in the petition as ''hypothetical and baseless'' (Br.Opp. 3) is untenable; the question in specific terms relates directly to the actual findings and record in the case at bar.

2. Re **the boundaries of ''subject matter sought to be patented'' and ''art to which said subject matter pertains''** in testing obviousness under new section 103: Respondents' short catalogue of selected pre-section-103 instances where this Court has held patents invalid because practically identical contrivances were already in existence for the same general purpose (Br.Opp. 9-10),[1]

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[1]The cases cited did not deal with obviousness, but with newness: *Brown et al. v. Piper* (1875) 91 U.S. 37—apparatus for preserving fish and meat in a freezing chamber held invalidly patented in light of identically functioning apparatuses for freezing and preserving corpses and for freezing ice cream.

Blake v. San Francisco (1885) 113 U.S. 679—automatic valve for steam fire engine held invalidly patented in light of prior use of similar automatic valve on steam feed-pumps of steamships, fitted with hose attachments for use as steam fire engines (113 U.S. 683)—identical devices, identical use, the only difference being use on land rather than at sea.

Stephenson v. Brooklyn Railroad Co. (1885) 114 U.S. 149—rock-shaft device for remote opening of street-car doors held invalidly patented after prior use of rock-shafts for opening doors

does not meet the issue of nonobviousness where the alleged prior art is in a totally different field and serves a wholly foreign purpose. In the only post-section-103 case cited, *Calmar, Inc. v. Cook Chemical Co.* (1966) 383 U.S. 1, the Court found that, as to patented dispenser bottles for liquids with hold-down caps where the differences lay only in a pop-up pump sprayer vs. a pouring spout as the dispensing feature, the arts were so closely related as to make the latter type a pertinent reference.[2] None of the cases cited defines the undefined but critical terms in section 103.

3. Re **the conflict of decisions** cited in the petition: Respondents' characterization of the decisions conflicting with the decision below as ex parte or "maverick" (Br. Opp. 11), far from dismissing them as illustrations of conflicting authority, rather emphasizes them as such and points up the need for definitions emanating from this Court. Reference to the decisions of the Court of Customs and Patent Appeals (a court of equal standing with the

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of railway carriages (114 U.S. 152) and sliding window-shutters (114 U.S. 154).

Howe Machine Co. v. National Needle Co. (1890) 134 U.S. 388—lathe for shaping and pointing sewing-machine needles held invalidly patented after prior use of identical combination for shaping and pointing skewers for use in spinning yarn (134 U.S. 393)—the only difference being in processing metal instead of wood.

Cuno Corp. v. Automatic Devices Corp. (1941) 314 U.S. 84—thermostatic circuit breaker on cordless cigar and cigarette lighter held invalidly patented after prior patents for thermostatic circuit breakers in fixed cigar lighters, electric heaters, electric flat irons, and electric toasters (314 U.S. 88-89).

[2]*Calmar* appears to turn more upon the resolution of a dispute as to the precise scope of the ultimately allowed claims (383 U.S. 32-35), than upon principle. The alleged definition of pertinent art quoted at page 3 of the Brief in Opposition is not to be found in the Court's opinion.

court below) as "uncontested" is unsound in any event; in these cases the patent applicant and the Patent Office are adversaries, contesting through counsel their opposing positions with problems of the prior art frequently a prime issue.

4. Re **the specific findings of nonobviousness to a person of ordinary skill in the art,** which were evidence-supported and uncontradicted, but which the court below overrode (Petn. 12, 32-33; Findings 53 and 63):[3] Respondents do not mention Finding 63 at all, and Finding 53 only in passing but not as regards the fact of nonobviousness; yet these are the precise findings of the precise facts upon which the application of section 103 turns.

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[3] [C.T. 953:]

"53. Before the inventions in suit only vehicle-sensitive safety apparatus was known for protecting a man in his seat in a moving vehicle while permitting the man to carry out his normal movements, and it was not known that abnormal movement of the man could be sensed to cause the man to be locked in his seat as soon as the abnormal movement starts. At the time the inventions in suit were made, it would not have been obvious to one skilled in the art of safety apparatus for protecting a man in his seat that abnormal movement of a man could be sensed to cause the man to be locked in his seat at the very outset of the abnormal movement" (Petn. A. 23).

[C.T. 955:]

"63. The subject matter of the patents in suit was not obvious to the military services which had a great need for such safety apparatus, because the lives of pilots were being lost; it was not obvious to the highly skilled engineers of American Seating Company who were endeavoring to overcome the shortcomings of their vehicle-sensitive safety apparatus; and the Air Force was skeptical of the man-sensitive concept. The subject matter of the patents [C.T. 956] in suit was not obvious to one skilled in the art, and the inventions produced surprising results (locking a man in his seat in a small fraction of a second due to abnormal acceleration of the man in any direction by sensing the acceleration of the man with respect to his seat) using a technique which the Air Force did not think would work satisfactorily" (Petn. A.26).

Respondents' references to other evidentiary findings (Br. Opp. 14-15) are irrelevant.

Nothing in the Brief in Opposition touches the case before this Court,[4] which in summary shows:

Actual conflict and confusion exists as between the decision below and other post-section-103 decisions (Petn. 13-23).

Authoritative definitions, boundaries and guidelines as to the meaning of key terms in section 103 are sorely needed—"the subject matter sought to be patented" and "the art to which said subject matter pertains." Until this Court speaks, uncertainty in dealing with 90,000 patent applications per year and with scores of litigated cases must persist (Petn. 23-27).

As to the particular patents in issue: Despite long-felt life-or-death need, petitioner's devices were the first that solved the problem. Here "the differences between the subject matter sought to be patented and the prior art" (35 U.S.C. 103) were that prior devices did not do the job, petitioner's did. Respondents bought them, studied them, canceled an order for a large quantity of them, and then manufactured their own along the same lines (Petn. 10).

The trial court found as a fact, with all the evidence before it, that petitioner's inventions were not obvious at the time from prior developments, to persons having ordinary skill in the art of vehicle-occupant safety

[4]Rather than meeting the issues presented by the petition, respondents tilt with past arguments directed to the court of appeals (e.g., Br.Opp. 6-7, 8-9, 14-15).

apparatus (supra, p. 4). The court below overrode these findings with nothing but hindsight speculation to go on (Petn. 12, 32-33). Petitioner's devices demonstrate a high order of complexity and ingenuity (Exhs. 1 and 2; R.T. 24). The questions—to what a person ordinarily skilled in the art of vehicle-occupant safety apparatus would reasonably be expected to look for a solution, what the prior art would teach to such a person in that regard, and whether or not the subject matter would be obvious to such a person therefrom—are fact questions entwined with much engineering and scientific expertise. When the trier of fact has found these facts upon all the evidence, Rule 52 of the Federal Rules of Civil Procedure does not permit the court of appeals to substitute its hindsight judgment.

Petitioner's patents take nothing out of the public domain which is already there; they do seek to give petitioner the degree of protection which the Constitution and statutes provide to the invention which petitioner owns.

The basic difficulty is that this Court has not yet defined the central terms of section 103. Unless and until this Court will declare either: that the ultimate purpose and application of whatever principle (mechanical, physical, or chemical as the case may be) is employed is meaningless (as held by the court below), or is a significant and perhaps controlling factor in the obviousness test, (as held in *Van Wanderham et al.*[5]—Petn. 17-21), the conflicting

[5]*Application of Van Wanderham* (C.C.P.A. 1967) 378 F.2d 981, and other cases cited (Petn. 17-21).

decisions, confusion and uncertainty must be expected to persist.

We respectfully submit that the petition for a writ of certiorari should be granted.

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